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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,559	02/09/2000	Manjit S. Chowdhary	ECO530/4-2	4061

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EXAMINER
TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
1712	

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12

Please find below and/or attached an Office communication concerning this application or proceeding.

11

Office Action Summary	Application No. 501559	Applicant(s) CHOWDHARY
	Examiner P. TUCKER	Group Art Unit 1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 7/26/02 - request for CPA.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1 - 70 is/are pending in the application.

Of the above claim(s) 12-26, 33 and 40 is/are withdrawn from consideration.

☒ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 - 11, 27 - 32, 34 - 39, 41 - 70 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)–(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)–(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☐ Information Disclosure Statement(s), PTO–1449, Paper No(s). _____

☐ Interview Summary, PTO–413

☐ Notice of Reference(s) Cited, PTO–892

☐ Notice of Informal Patent Application, PTO–152

☐ Notice of Draftsperson's Patent Drawing Review, PTO–948

☐ Other _____

Office Action Summary

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 7/26/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/501559 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 2, 5-11, 27-30, 34-37, 41-66, 69 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rutenberg et al. (4269975).

Rutenberg teaches a method of preparing a ground guar which is made from hydrated guar splits (see abstract). Rutenberg teaches that extruding the guar, prior to grinding results in a gum which produces increased viscosity products (see Example II). Rutenberg also teaches that flaking of the guar prior to grinding, results in a product with higher viscosity than nonflaked guar (column 7, lines 4-20). Moisture content and mesh size which are the same as the present

invention are disclosed at column 4, lines 1-4 and lines 44-49. Rutenberg differs from the present invention in that the use of both flaking and extruding, in the preparation of the ground guar is not disclosed. The courts have held , such as In re Crockett 126 USPQ 186, that combining such methods would not be patentable, since it would logically flow that the combination would produce the same effect, and would supplement each other. It would thus be obvious to one of ordinary skill in the art to utilize both extruding and flaking of the guar, in the process of making ground guar, given the teaching of Rutenberg that extruding and flaking produce superior ground guar from guar splits, than guar not subject to extruding or flaking. Rutenberg also differs in not specifying an extruding barrel of 2 - 8 inches, or the use of chemically or genetically modified guar. The utility of barrels of differing size, in order to optimize the processing of the guar would be an obvious variation to one of ordinary skill in the art (In re Rose 105 USPQ 237). Although Rutenberg does not teach the hydration rate properties at specific temperatures disclosed in claims 41-70, the mere discovery of a property of an obvious composition has been held to not alone render patentability by the courts. In re Dillon 16 USPQ2d 1897 states "but discovery that claimed composition possesses property not disclosed for prior art does not alone defeat a prima facie case, and it is not necessary, in order to establish prima facie case, to show both structural similarity between claimed and prior art compound and suggestion in, or expectation from, prior art that claimed compound will have the same or similar utility as one newly discovered by applicant". Thus applicants mere discovery of the property of hydration rates at specific temperatures does not render patentability to the composition.

4. Claims 1, 3, 4, 27, 31, 32, 34, 38 , 39, 66-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rutenberg et al. (4269975) in view of Dino (5646093), Harris (5990052) and Applicants specification.

Rutenberg teaches a method of preparing a ground guar which is made from hydrated guar splits (see abstract). Rutenberg teaches that extruding the guar, prior to grinding results in a gum which produces increased viscosity products (see Example II). Rutenberg also teaches that flaking of the guar prior to grinding, results in a product with higher viscosity than nonflaked guar (column 7, lines 4-20). Moisture content and mesh size which are the same as the present invention are disclosed at column 4, lines 1-4 and lines 44-49. Rutenberg differs from the present invention in that the use of both flaking and extruding, in the preparation of the ground guar is not disclosed. The courts have held , such as In re Crockett 126 USPQ 186, that combining such methods would not be patentable, since it would logically flow that the combination would produce the same effect, and would supplement each other. It would thus be obvious to one of ordinary skill in the art to utilize both extruding and flaking of the guar, in the process of making ground guar, given the teaching of Rutenberg that extruding and flaking produce superior ground guar from guar splits, than guar not subject to extruding or flaking. The utility of chemically or genetically modified guar as an alternative to guar in the industrial uses disclosed by Rutenberg at column 1, lines 8-12 are well known, and would be obvious to one of ordinary skill in the art. In support of such knowledge in the art, Dino in Example 1, and

Harris at column 8, lines 35-37 teach the use of guar splits to form chemically modified guar products which are used in operations such as oil well drilling and fracturing. Applicants specification at page 9, lines 15-27 clearly teach that it is known in the art to chemically modify guar gum, and genetically modify plants in order to produce the guar products, thus such variations would be obvious variations to one of ordinary skill in the art.

Although Rutenberg does not teach the hydration rate properties at specific temperatures disclosed in claims 41-70, the mere discovery of a property of an obvious composition has been held to not alone render patentability by the courts. In re Dillon 16 USPQ2d 1897 states "but discovery that claimed composition possesses property not disclosed for prior art does not alone defeat a prima facie case, and it is not necessary, in order to establish prima facie case, to show both structural similarity between claimed and prior art compound and suggestion in, or expectation from, prior art that claimed compound will have the same or similar utility as one newly discovered by applicant". Thus applicants mere discovery of the property of hydration rates at specific temperatures does not render patentability to the composition.

5. Applicants arguments have been considered but are not deemed persuasive. Applicants amendment has overcome the rejection with respect to claim 2. With respect to applicants arguments that not all the steps of the claims art taught by Rutenberg, grinding and drying is taught at column 3, line 58 - column 4, line 5. Also hydrating, flaking, grinding and extruding are taught, for example, from column 4, line 50 - column 7, line 20. Moisture content and mesh

size which are the same as the present invention are disclosed at column 4, lines 1-4 and lines 44-49. All claims are covered by the above scope or by the case law applied. Applicant has not pointed to any claims which were not addressed by the scope of the rejections presented, either in the content of the references or in the case law applied. The scope of the invention is thus encompassed by Rutenberg, and the other references of the rejections. With respect to applicants arguments that the combination of flaking and extruding is not obvious over Rutenberg, although Rutenberg differs from the present invention in that the use of both flaking and extruding, in the preparation of the ground guar is not disclosed, the courts have held , such as in In re Crockett 126 USPQ 186, that combining such methods would not be patentable, since it would logically flow that the combination would produce the same effect, and would supplement each other. Contrary to applicants assertion the flaking and extruding elements are clearly disclosed, and they are linked in view of the cited case law. A clear prima facie case has thus been made.

Applicant has again made an allegation of the use of personal knowledge. Every point of the rejections have been made upon teachings of the prior art, or upon case law. The increasing of hydration rates is a property which according to case law (In re Dillon, supra) does not alone provide a patentable distinction. Applicant is not claiming a method in which such might be distinguishing. Applicant has not also shown any superior and unexpected results from the teachings of the specification, affidavit or declaration to show that the properties of the present product are superior and unexpected, over the properties of the product of Rutenberg. A disagreement over the clarity of the prior art is not a reason for the submission of an affidavit by

the examiner. The prior art clearly teaches, in view of the case law, contrary to applicants assertion, all of the elements of the present invention. The rejections are maintained.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. Is 703-872-9311.

PCT-2661
October 17, 2002

PHILIP C. TUCKER
ART UNIT 1712